

REMARKS

Claims 4-29 are currently pending in the application. Applicants have canceled claims 1-3. Applicants request reconsideration of the application in light of the following remarks.

Double Patenting Rejection

Claims 1-29 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 108-206 and 268-300 of copending application number 09/578,001. Applicant notes this provisional rejection and will submit an appropriate terminal disclaimer if the claims become patented to establish the rejection.

Claims 1-29 also stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6 of U.S. Patent No. 6,221,145. Although Applicant strongly disagrees with the Examiner's assertion that transport of pre-paint components to a point of sale prior to mixing the components is "so notoriously well known as to preclude the citation of a reference," Applicant elects to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejection in compliance with 37 CFR §1.321 (b) and (c). Applicants' filing of the terminal disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections. Attached is the terminal disclaimer and accompanying fee.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Friel et al. (U.S. Patent No. 6,531,537, hereinafter "Friel"). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Claims 1-3 have been canceled, thus obviating the rejection of those claims. Claims 4-29 each have support and claim priority to Applicant's earlier application that issued as U.S. Patent No. 6,221,145 (filed December 23, 1998). Claims 4-29 do not claim the new subject matter added with the CIP application on 5/24/00. This priority date predates the earliest possible priority date of Friel by approximately 14 months. Accordingly, among other reasons for being patentably distinct from Friel, Friel is an improper reference for use in rejecting these claims.

Applicants respectfully request that the obviousness rejections of claims 4-29 based upon Friel be withdrawn.

Claims 1-29 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over each of a large number of references listed at pages 5 and 6 of the most recent Office Action. "For the sake of simplicity and to avoid undue confusion and duplication," the Examiner treated each of these references as being substantially equivalent and asserted that the claims should be rejected for being "directed to an invention that significantly overlaps in scope that set forth in the prior art" without specifically addressing each of the references. Applicant was unable to find each and every element of every claim in the cited references. Because each of these references are long, and the Examiner considers them to each disclose substantially the same invention, Applicant will specifically address those references the Examiner has specifically cited by page and line number - "for the sake of simplicity" to make the overall point.

Applicant's claims 4-29 recite detailed and specific compositions for pre-mixed components for use in making paint. Some of the references cited also disclose systems that use pre-mixed components to make paint, but they are not the same combination as recited in Applicant's claims. Applicant's combination is different from the references cited, and the Office has not yet identified a reference that teaches or suggests all of the elements of any claim. Rather, the Office Action glosses over the actual elements of the claims and apparently presumes that Applicant is attempting to patent the general concept of making paint from any pre-mixed components rather than the specific pre-mixed components recited in the claims.

Because combinations of prepaints with different base compositions will result in different chemistry when mixed, the Office must identify references that have the specifically claimed combinations, or some teaching or suggestion to form the specific prepaints along with some teaching, suggestion or motivation to use each of those particular prepaints together, to establish a *prima facie*, case of obviousness. The Office has not yet met its burden.

For example, the most recent Office Action cites page 156 of "Component Mixing . . ." which only mentions that paint can be made through premixed components and gives no detail as to what is in the components or specific compositions will work together. The most recent Office Action also cites pages 228-232 of the "Paint Dispensing System", which likewise only mentions making paint through premixed components and does not disclose Applicant's claimed combination for doing so.

On U.S. Patent 4,403,866 to Falcoff (hereinafter "Falcoff"), the most recent Office Action references the drawing, cols. 1-2, col. 5, lines 23-36 and the examples as disclosing the invention. The drawing illustrates only that premixed components, controlled by a computer, may be mixed to form paint. Cols. 1 and 2, col. 5, lines 23-36 and the examples are a bit more specific in that they mention a "liquid containing binder, a solvent, and a colorant, but Falcoff does not give any details on the components included in each of these premixed components, and certainly does not disclose each of a "pigment composition", a

“dispersant thickening dilutant composition”, a “low resin composition”, and a “high resin composition” as claimed by Applicant. Falcoff focuses on obtaining the right color of paint rather than what the various components of the paint are.

Lastly, relating to U.S. Patent 5,672,649 to Brock (hereinafter “Brock”), the most recent Office Action references col. 1, line 57 to col. 3, line 38 as disclosing the invention. More relevant than Falcoff, but still not disclosing Applicant’s claimed methods, Brock discloses each of a “special effect module”, an “aqueous binder”, a “dye module”, a “rheology module” and a “cross-linking module.” At col. 2, the components of each of these modules is identified, but the modules are different from Applicant’s modules and do not include the same combinations of components to make the modules. Again, Applicant has claimed a specific combination of components to make each prepaint and a specific combination of prepaits for each claim. The approach of Brock does not teach or suggest the specific combination claimed by Applicant.

For the remaining references, the Examiner merely asks that Applicant “see the entire disclosures of the remaining documents”. Applicant has reviewed the disclosures and was unable to identify Applicant’s claimed invention within the disclosures. They, like the other references, appear to be references that describe someone’s approach to forming paint from premixed components, but not Applicant’s claimed approach.

Accordingly, Applicant respectfully requests that the obviousness rejection of claims 4-29 be withdrawn and a notice of allowance be issued for the claims.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION


Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

It is requested that a two-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$215.00 is enclosed herewith.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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